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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,264	02/05/2004	George Bayer	2350.422	8672

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EXAMINER

REESE, DAVID C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,264

Applicant(s)

BAYER ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9,10,12-14,23-25,50,51,54-59 and 63-69 is/are pending in the application.
- 4a) Of the above claim(s) 29-39,61 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10,12-14,23-25,50,54-58 and 63-67 is/are rejected.
- 7) ☒ Claim(s) 9,68 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/10/2006 has been entered. Consequently, the following is the current listing of claims in the instant application:

Status of Claims

- Claims 2, 5-8, 11, 15-22, 26-49, 52-53, and 60-62 are canceled.
- Claims 1, 10, 12, 23, 29, 37, 54, 61, 63, and 66-69 were amended.
- Claims 29-39 and 61-62 are withdrawn (see below).
- Claims 1, 3-4, 9-10, 12-14, 23-25, 50-51, 54-59, and 63-69 are pending.

Election/Restrictions

[1] Claims 29-39, and 61-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant's election with traverse of Claims 1, 3-4, 9-10, 12-14, 23-25, 50-51, 54-59, and 63-69 in the reply filed on 9/22/2006 is acknowledged. The traversal is on the ground(s) that since the claims recited in Group II and I have been the subject of examination for almost a year, and therefore, the examination of both of these inventions does not require any additional effort by the Patent Office. The examiner disagrees, and would like to note that a requirement for a restriction may be called for at any point during prosecution in a case, and therefore the instant restriction is considered proper by the examiner. Further, the applicant states that the claims

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from group II have been canceled in the response to the restriction requirement filed 9/22/2006.

The status identifiers, however, do not denote this the case. The examiner, therefore, recognizes that the claims from group II are withdrawn at the present time, and if the applicant would like to cancel said claims he may do so in response to this correspondence.

The requirement is still deemed proper and is therefore made FINAL.

Specification

[2] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 7/10/2006. Accordingly, the objection(s) to the specification have been withdrawn.

Claim Rejections - 35 USC § 112

[3] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 7/10/2006. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

Claim Rejections - 35 USC § 102

[4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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[5] Claims 1, 3-4, 10, 12-14, 23-25, 50, 54-58, 63-64 are rejected under 35 U.S.C. 102(b) as clearly anticipated by EP 0200924, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

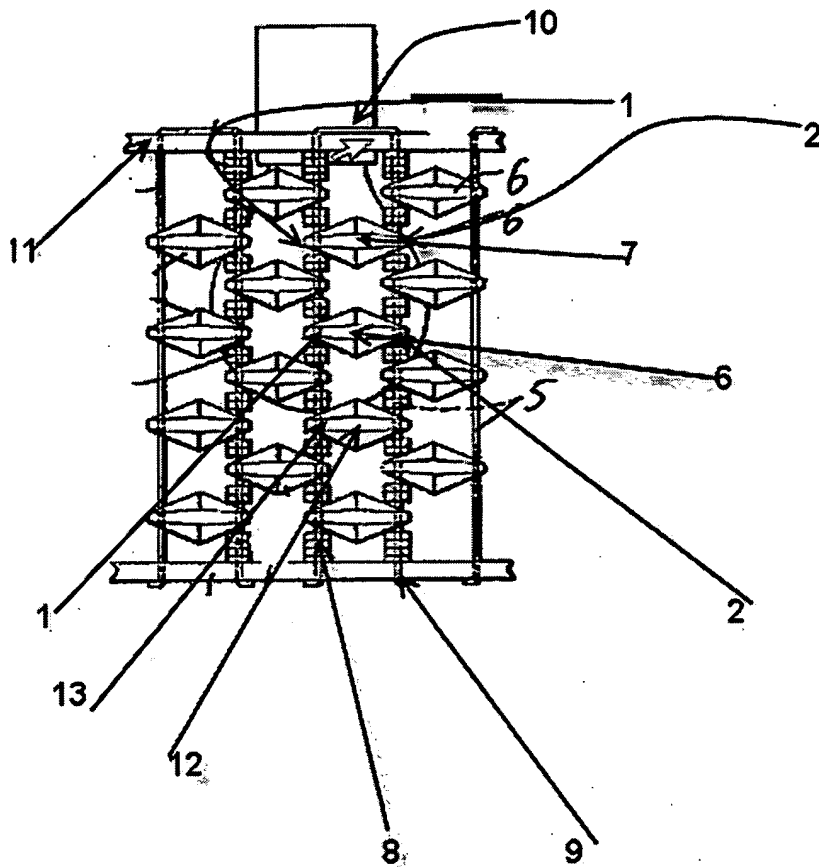
As for Claim 1, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 23, see figure below) comprising:

- a first ornament (6) having at most a first aperture (1) and a second aperture (2);
- a second ornament (7) having at most a first aperture (1) and a second aperture (2); and
- a first connector wire (8) (page 14, line 23, "...of a generally metallic wire forming...") having a first end inserted into and bent to engage the first aperture (1) of the first ornament (6) and a second end inserted into and bent to engage the first aperture (1) of the second ornament (7); and

- a second connector wire (9) (page 14, line 23, "...of a generally metallic wire forming...") having a first end inserted into and bent to engage the second aperture (2) of the first ornament (6) and a second end inserted into and bent to engage the second aperture (2) of the second ornament (7);

whereby the second aperture (2) of the first ornament (6) is laterally disposed from the first aperture (1) of the first ornament (6).

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Re: Claim 3, wherein the second aperture (2) of the second ornament (7) is laterally disposed from the first aperture (1) of the second ornament (7).

Re: Claim 4, wherein the second aperture (2) of the first ornament (6) is opposite the first aperture (1) of the first ornament (6).

Re: Claim 10, wherein at least the first connector (8) comprises at least one-pre-formed U-shaped wire connector (10) having ends adapted to be inserted into an aperture of an ornament (6).

Re: Claim 12, wherein the decorative ornaments (6) comprise one or more of beads, crystals, stones, and gems (6).

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Re: Claim 13, wherein at least the first wire connector (8) comprises a metallic wire having a diameter between about .0625 inches and about .125 inches.

Re: Claim 14, wherein the first ornament (6) and the second ornament (7) comprise octagonal ornaments.

As for Claim 23, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 23, see figure above) comprising:

at least one ornament (6 or 7) having at most a first aperture (1) and a second aperture (2); and

at least one hook (10) having a first end (8) inserted into and bent to engage the first aperture (1) of the ornament (6 or 7), a second end (9) inserted into and bent to engage the second aperture (2) of the ornament (6 or 7), and a loop (below 10) positioned between the first end (8) and the second end (9), the loop (below 10) [adapted to be] hung from a support (11);

wherein, when hung by the loop (below 10), the second aperture (2) of the ornament (6 or 7) is laterally disposed from the first aperture (1) of the ornament (6 or 7).

Re: Claim 24, wherein the one or more decorative ornaments (6) comprise one or more of beads, crystals, stones, and gems (6).

Re: Claim 25, wherein the at least one hook (10) comprises a wire (8, 9) having a diameter between about .0625 inches and about .125 inches.

Re: Claim 50, wherein the first ornament (6) and the second ornament (7) comprise two of a plurality of ornaments providing an ornament chain (Fig. 23).

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Re: Claim 63, wherein the first connector (8) and the second connector (9) comprise at least one pre-formed U-shaped connector (10) having ends adapted to be inserted into and secured to an aperture (1, 2) of an ornament (6,7).

Re: Claim 64, wherein the first connector (8) and the second connector (9) comprise metallic wire having a diameter between about .0625 inches and about .125 inches.

As for Claim 54, EP 0200924 teaches of an arrangement for connecting decorative ornaments the arrangement (Fig. 23, see figure above) comprising:

- a first ornament (6) having at most a first aperture (1) and a second aperture (2);

- a second ornament (7) having at least a first aperture (1);

- at least a third ornament (12) having at least one aperture (13); and

- at least one continuous connector (8) adapted to be inserted into and bent to engage an aperture of at least the first ornament (6), the second ornament (7), and the third ornament (12),

- and wherein the first ornament (6), the second ornament (7), and the third ornament (12) are in spaced relationship with each other;

- whereby the second aperture (2) of the first ornament (6) is laterally disposed from the first aperture (1) of the first ornament (6).

Re: Claim 55, wherein the at least one continuous connector (8) comprises a connector fabricated from one of sheet and plate.

Re: Claim 56, wherein the at least one continuous connector (8) comprises at least two continuous connectors (8, 9).

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Re: Claim 57, wherein the at least one continuous connector (8, 9) fabricated from one of sheet and plate is fabricated by one or more of the following processes: laser cutting, water-jet cutting, and electro-discharge machining.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Re: Claim 58, wherein the first ornament (6), second ornament (7), and third ornament (12) comprise a plurality of ornaments providing an ornament chain.

Claim Rejections - 35 USC § 103

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claims 51, 59, 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0200924, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 51, 59, and 65, EP 0200924 teaches of that from Claim 1 and Claim 54, respectively.

The difference between the claims and EP 0200924 is that the claims recite that the ornament chain is at least 5 feet in length; and that said ornament chain comprises a single-row chain of at least 10 ornaments. It would have been an obvious matter of design choice to alter the size and length of the ornamental chain by adding ornaments to said chain. First and foremost, it has been held that mere duplication of the essential working parts of a device involves only routine skilled the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8); and further, since such a modification would have involved a mere change in the size of a component in its entirety, such is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re: Claim 66, wherein the first wire connector and the second wire connector [are adapted to reduce aperture loading on the at least 10 ornaments compared to aperture loading on ornaments mounted with single wire connectors].

Re: Claim 67, wherein the first wire connector and the second wire connector [are adapted to minimize misalignment of the at least 10 ornaments compared to ornaments mounted with single wire connectors].

The above statements in brackets are examples of intended use as they fail to further limit the structure of the claimed invention.

Note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Allowable Subject Matter

[8] Claims 9 and 68-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As for Claim 9, the prior art, incorporating other corresponding limitations as set forth above, does not teach or disclose of a jewelry arrangement further comprising at least one third connector connecting the second ornament and a third ornament.

As for Claims 68, the prior art, incorporating other corresponding limitations as set forth above, does not teach or disclose of the continuous connector comprising loops adapted to be inserted into and bent to engage ornament apertures. Claim 69 is dependent upon claim 68.

Response to Arguments

[9] Applicant's amendment and arguments filed 7/10/2006 regarding rejections under 35 U.S.C. 102 (with specific regard to Figs. 11-12) have been fully considered. Due to the amendment to the claims, the prior art (with specific regard to Figs. 11-12) fails to further anticipate. Figs. 11-12 do not disclose of first and second wire connectors inserted into and bent to engage apertures of first and second ornaments. Accordingly, the Examiner has withdrawn all previous rejections over Fig. 23 of EP 0200924.

[10] Applicant's amendments and arguments filed 7/10/2006 regarding rejections under 35 U.S.C. 102 (with specific regard to fig. 23) have been fully considered but they are not

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persuasive. The prior art of EP 0200924 is still considered by the examiner as being anticipatory towards the above amended claims. The examiner still maintains that in the broadest reasonable interpretation possible, the wire connectors can and are considered as being inserted into and bent to engage the apertures of the various ornaments. The applicant states in the remarks that the wire 5 does not engage each aperture in ornament as claimed. The examiner disagrees. The claim never states at what location the wire is bent so that the wire is engaged into the aperture of the ornaments. Is the wire bent before or while inside the aperture for example? Further clarification with respect to the claim language may help to properly differentiate this possibly distinct feature in the instant invention from that of Fig. 23 of EP 0200924.

In addition, the examiner also would like to note that a further difference between the prior art of EP 0200924 and the instant invention may reside in the fact that the first and second ends of the connectors terminate (in least in one embodiment) at or just around the apertures of the ornament (or right after being bent), not progressing to other multiple ornaments.

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Conclusion

[11] THIS ACTION IS NON-FINAL

[12] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

[13] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3677

DCR



11/2/06



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PRIMARY EXAMINER